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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/857,123

07/30/2001

Natalie Samantha Delany

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06/29/2004

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EXAMINER

ANDRES, JANET L

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/857,123

Applicant(s)

DELANY ET AL.

Examiner

Janet L. Andres

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-5 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, 2, 4, and 48-50, drawn to VR1 polypeptides.

Group II, claim(s) 1, 3, 5, 48, 49, and 51, drawn to VR3 polypeptides.

Group III, claim(s) 6, 7, 9, 10, 12, 14, 15, 17, 18, 20, 21, 45, 46, drawn to VR1 polynucleotides and means of expression.

Group IV, claim(s) 6, 8, 9, 11, 13, 14, 16, 17, 19, 20, 22, 45, and 47, drawn to VR3 polynucleotides.

Group V, claim(s) 23 and 24, drawn to VR1 antibodies.

Group VI, claim(s) 23 and 25, drawn to VR3 antibodies.

Group VII, claim(s) 26, drawn to methods of screening for VR1 effectors.

Group VIII, claim(s) 26, drawn to method of screening for VR3 effectors.

Group IX, claim(s) 27-44, drawn to VR1 effectors and methods of use.

Group X, claim(s) 27-44, drawn to VR3 effectors and methods of use.

Claims appear in more than one group if they encompass more than one invention.

The inventions listed as Groups I-X do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

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The technical feature that links the polypeptides is that they are vanilloid receptors. Since such receptors are known in the art (see, for example, U.S. patent 6,239,267) this feature is not an inventive concept.

The polypeptides and polynucleotides lack a common technical feature because the polynucleotides include molecules that do not encode polypeptides.

The polypeptides and antibodies lack a common technical feature because they are structurally and functionally unrelated.

The polypeptides and screening methods lack a common technical feature because the polypeptides have other uses, such as antibody generation, that are unrelated to the methods.

The polypeptides and the effectors lack a common technical feature because they are structurally and functionally unrelated and the polypeptides cannot be used in the methods.

The polynucleotides and antibodies lack a common technical feature because they are structurally and functionally unrelated.

The polynucleotides and screening methods lack a common technical feature because the methods do not require the polynucleotides.

The polynucleotides and the effectors lack a common technical feature because they are structurally and functionally unrelated and the polynucleotides cannot be used in the methods.

The antibodies and screening methods lack a common technical feature because the antibodies can be identified in other ways, such as by blotting.

The antibodies and the effectors lack a common technical feature because the effectors include molecules that are structurally and functionally unrelated to the antibodies.

The screening methods and the effectors lack a common technical feature because the effectors can be identified in other ways, such as by binding assays, and the two methods require unrelated agents and have unrelated goals.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Andres whose telephone number is 571-272-0867. The examiner can normally be reached on Monday-Thursday and every other Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Janet L. Andres, Ph.D.  
Primary Examiner

25 June 2004

  
**JANET ANDRES**  
**PATENT EXAMINER**